

REMARKS

The paper is in response to the Non-Final Office Action mailed January 17, 2013 (the “Office Action”). No claims are amended herein. Claim 1 was cancelled in a previous paper. Claims 2-18 remain pending. Applicants respectfully request reconsideration of the application in view of the following remarks.

Unless otherwise explicitly stated, the term “Applicants” is used herein generically and may refer to a single inventor, a set of inventors, an appropriate assignee, or any other entity or person with authority to prosecute this application.

Rejections Under 35 U.S.C. 251

The Office Action rejects claims 2-18 under 35 U.S.C. 251 as being based upon a defective reissue declaration. In particular, the Office Action asserts two defects: 1) that “The reissue declaration dated 27 September 2012 does not contain an error statement,” and 2) that “The reissue declaration, dated 21 November 2008, states the error was failing to provide a certified copy of German priority document 196 22 459.4, filed 24 May 1996 prior to the issuance of US Patent No. 6,014,476. However, there is no copy of German priority document 196 22 459.4 filed within this reissue application either.” Applicants respectfully traverse these rejections because neither of these two purported defects are actual defects.

With regard to the Office Action’s assertion that “The reissue declaration dated 27 September 2012 does not contain an error statement,” Applicants respectfully note that the reissue declaration filed on September 27, 2012 is a Supplemental Reissue Declaration, and as such does not need to include an Error Statement. In particular, MPEP 1414.01, under the heading “I. WHEN AN ERROR MUST BE STATED IN THE SUPPLEMENTAL OATH/DECLARATION” directs Examiners as follows:

In the supplemental reissue oath/declaration, ***there is no need to state an error*** which is relied upon to support the reissue application if:

- (A) an error to support a reissue has been previously and properly stated in a reissue oath/declaration in the application; and
- (B) that error is still being corrected in the reissue application.

If applicant chooses to state any further error at this point (even though such is not needed), ***the examiner should not review the statement of the further error.***

(Emphasis added). Since previous reissue declaration properly stated an error to support reissue and since that same error is still being corrected in the present reissue application, MPEP 1414.01(I) clearly states that the Supplemental Reissue Declaration filed on September 27, 2012 does ***not*** need to state an error which is relied on to support the present reissue application. Further, to the extent that the Examiner construes any statement in the Supplemental Reissue Declaration filed on September 27, 2012 as a statement of further error, MPEP 1414.01(I) clearly states that the Examiner should ***not*** review the statement of the further error. Therefore, the Office Action's assertion that "The reissue declaration dated 27 September 2012 does not contain an error statement," while true, does not support rejecting claims 2-18 under 35 U.S.C. 251.

With regard to the Office Action's assertion that "there is no copy of German priority document 196 22 459.4 filed within this reissue application either," Applicants respectfully note that German priority document 196 22 459.4 was filed in the parent of the present reissue application, U.S. Patent Application No. 09/198,692 which issued as U.S. Patent No. 6,014,476, and therefore there is no need to re-file the German priority document 196 22 459.4 in the present reissue application. MPEP 1417 directs Examiners as follows: "A 'claim' for the benefit of an earlier filing date in a foreign country under 35 U.S.C. 119(a)-(d) must be made in a reissue application, even though such a claim was previously made in the application for the original patent to be reissued. However, ***no additional certified copy of the foreign application is necessary.*** The procedure is similar to that for 'Continuing Applications' in MPEP § 201.14(b)." *(Emphasis added)*. In the present reissue application, a certified copy of the foreign application, German priority document 196 22 459.4 was filed with a petition under 37 C.F.R. 1.55(a) in the application of the original patent to be reissued, U.S. Patent Application No. 09/198,692, which issued as U.S. Patent No. 6,014,476. *See Declaration filed January 22, 2001, error statement.* Further, the USPTO is on record acknowledging that this certified copy of the foreign application was received in the application of the original patent to be reissued. In particular, in the very first office action received in the present reissue application, the USPTO stated: "Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

All Certified copies of the priority documents have been received in Application No. 09/198,692.” See office action mailed May 21, 2008, Office Action Summary. For the convenience of the Examiner, the relevant page of this first office action is reproduced below with a box drawn around the relevant acknowledgment:

Office Action Summary	Application No.	Applicant(s)	
	09/767,801	MEYER-GULDNER ET AL.	
	Examiner	Art Unit	
	Kevin S. Wood	2874	

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

— Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

— If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.

— Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may require any claimed patent been adjusted. See 37 CFR 1.203(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-6 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-6 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on 22 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-457.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some * c) ☐ None of:

1) ☐ Certified copies of the priority documents have been received.

2) ☒ Certified copies of the priority documents have been received in Application No. 09/198692.

3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-848)

3) ☐ Information Disclosure Statement(s) (PTO-859/860)

4) ☐ Interview Summary (PTO-413)

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____

7) ☐ Paper Note(s) (Mail Date: _____)

Since MPEP 1417 clearly states that “*no additional certified copy of the foreign application is necessary*” where “a claim was previously made in the application for the original patent to be reissued,” and since the USPTO has expressly gone on record acknowledging that “*All Certified copies of priority documents have been received*” in the application for the original patent to be reissued, there is no need to re-file the German priority document 196 22 459.4 in the present reissue application. Therefore, the Office Action’s assertion that “there is no copy of German priority document 196 22 459.4 filed within this reissue application either,” while true, does not support rejecting claims 2-18 under 35 U.S.C. 251.

Since the various declarations filed in the present reissue case are in order and complete, and since the foreign priority claim to German priority document 196 22 459.4 in the present reissue case is also in order and complete, Applicants respectfully submit that the rejection of claims 2-18 under 35 U.S.C. 251 is unsupported and unwarranted and should be withdrawn.

Charge Authorization

The Commissioner is hereby authorized to charge payment of any of the following fees that may be applicable to this communication, or credit any overpayment, to Deposit Account No. 50-5394: (1) any filing fees required under 37 C.F.R. §1.16; (2) any patent application and reexamination processing fees under 37 C.F.R. §1.17; and/or (3) any post issuance fees under 37 C.F.R. §1.20. In addition, if any additional extension of time is required, which has not otherwise been requested, please consider this a petition therefor and charge any additional fees that may be required to Deposit Account No. 50-5394.

CONCLUSION

In view of the foregoing, Applicants submit that the pending claims are allowable. The present reissue application has now been pending for **over 12 years**. In the event that Examiner finds remaining impediment to a prompt allowance of this application, Applicants respectfully request that the Examiner initiate a telephone interview with the undersigned attorney in order to expedite the issuance of this long-overdue application.

Dated this 1st day of April, 2013.

Respectfully submitted,

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